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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/833,347

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Rabindranath Dutta

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06/30/2006

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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/833,347		DUTTA ET AL.	
	Examiner		Art Unit	
	Dan Kesack		3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 13-15, 18, 31-33 and 46-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 16, 17, 19-30 and 34-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/19/01; 7/25/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: IDS 8/8/05; 10/24/05; 12/16/05; 1/30/06; 3/21/06.

DETAILED ACTION

1. This application has been reviewed. Original claims 1-48 are currently pending.
The rejections are as stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, 16, 17, 19-30, 34-45, drawn to a method for depositing a check in an automatic teller machine and processing the transaction, classified in class 705, subclass 43.
 - II. Claims 13-15, 18, 31-33, 46-48, drawn to a electronic funds transfer with electronic means providing security, and image processing with a video camera, classified in class 902, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §

806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I is directed towards a financial transaction. The subcombination has separate utility such as providing security for ATM transactions.

4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Jeffery LaBaw on June 15, 2006, a provisional election was made without traverse to prosecute the invention of group I, claims 1-12, 16, 17, 19-30, 34-45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-15, 18, 31-33, 46-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel those claims drawn to non-elected invention II, as stated above.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1, 12, 16, 19, 30, 34, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the claims contain the language, "wherein the image is in a format for use with a financial program," which renders the claim indefinite. It is unclear, from the language of the claim, what properties are required to meet the limitation of said "format", and what properties are required to meet the limitation of said "financial program." A broad range of programs varying in scope and function can be considered "financial programs." Also, a given financial program may or may not be used with any number of image formats. Furthermore, image formats are based on standards, which may change over time, and image formats and financial programs, unknown to the Applicant at the time of his invention, may be developed in the future, and it would be improper for the scope of the claim to change over time.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 9, 11, 12, 17, 27, 29, 30, 42, 44, 45 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ramster, "End of the Paper Chase." Banking Technology, v14, n6, p32-36, Jul/Aug 1997.

Claims 9, 17, 27, 42, Ramster discloses check imaging methods and technologies used by various financial institutions. Specifically, Ramster teaches receiving a check from a user at an ATM, scanning the check to generate an image, performing a transaction involving the check, and transmitting the image to the user in a manageable disk format (page 2 paragraphs 1, 2, 7-9).

Claims 11, 29, 44, Ramster teaches the scanned images are sent to email inboxes (page 4 paragraph 9).

Claims 12, 30, 45, Ramster teaches importing the image into the financial program (page 4 paragraph 9).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-4, 10, 16, 19-22, 28, 34-37, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramster, "End of the Paper Chase." Banking Technology, v14, n6, p32-36, Jul/Aug 1997, in view of Tobita, U.S. Patent No. 6,782,419.

Claims 1, 10, 16, 19, 28, 34, 43, Ramster discloses check imaging methods and technologies used by various financial institutions. Specifically, Ramster teaches receiving a check from a user at an ATM, scanning the check to generate an image, performing a transaction involving the check, and transmitting the image to the user in a manageable disk format (page 2 paragraphs 1, 2, 7-9).

While Ramster teaches providing image delivery services to customers, Ramster fails to teach delivering to a mobile device.

Tobita discloses a system and method for distributing images to a mobile phone. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ramster to include delivering images to a mobile device because Ramster teaches delivery to images to customers (page 2

paragraph 1), and the check being viewed by a user via the user's PC (page 2 paragraph 8). Furthermore, it is desirable to speed up the access of information, and therefore it would be obvious to make the mobile device, as described in Tobita, be used as the delivery recipient and the device through which to view the image.

Claims 2, 20, 35, Ramster teaches importing the image into the financial program (page 4 paragraph 9).

Claims 3, 4, 21, 22, 36, 37, Ramster and Tobita fail to teach where the financial program is located, however Applicant has admitted as prior art that financial programs are known both on mobile devices, and non-mobile devices.

13. Claims 5, 6, 23, 24, 38, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramster and Tobita and applied above, and further in view of Goldsmith, U.S. Patent No. 6,064,990.

Ramster and Tobita fail to teach sending an alert for the transaction, including an identification of the transaction.

Goldsmith discloses a system and method for electronic notification of account activity. Goldsmith teaches a transaction being made at an ATM and the user receiving a notification of the activity, including identification of the transaction (column 3 lines 48-57, column 4 lines 25-30). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the teachings of Ramster and Tobita to

include alerting the user of the transaction, as taught by Goldsmith because of the advantages of such a system, as described by Goldsmith, such as monitoring unauthorized activity, and verifying authorized activity.

14. Claims 7, 8, 25, 26, 40, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramster and Tobita and applied above, and further in view of Stinson, U.S. Patent No. 6,856,965.

Ramster and Tobita fail to teach capturing an image of the user at the ATM, and sending the image to the mobile device.

Stinson teaches a method and apparatus for automatic check cashing wherein a check is deposited at an ATM, and a camera captures an image of the user and sends the image to an outside system (column 2 lines 9-15). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ramster and Tobita to include capturing the image of the user upon depositing a check for the purposes of security, authorization verification, and transaction verification.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Blonder et al, U.S. Patent No. 5,708,422 discloses a transaction

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authorization and alert system. Jones et al, U.S. Patent No. 7,000,828 discloses a remote automated document processing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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PRIMARY EXAMINER